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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,202	02/01/2001	Johnny B. Corvin	UV-181	7104
1473	7590	11/25/2005	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			BELIVEAU, SCOTT E	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/775,202	CORVIN ET AL.
	Examiner	Art Unit
	Scott Beliveau	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,6-18,35,36 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-18,35,36 and 38-48 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 February 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1, 2, 6-18, 35, 36, and 40-48 of this application as follows:

- The provisional application fails to provide adequate support for “buffering the portion of the television program after the predetermined point in a buffer; and recording the portion of the television program after the predetermined point from the buffer” as recited in claims 1 and 35;
- The provisional application fails to suggest that the “promotion is selected based upon the content of the program” as recited in claims 2 and 36;
- The provisional application fails to provide adequate support for “recording a flag with the promotion to indicate the beginning of the program during playback” as recited in claims 8 and 41;
- The provisional application fails to suggest that the “promotion is recorded at any desired point within the program” recited in claims 11 and 44;
- The provisional application fails to provide support for the particular method of distribution of the program, the promotion, and the program guide over either a “single broadcast channel” or a “plurality of broadcast channels” as recited in claims 14, 15, 46, and 47;

- The provisional application does not disclose details regarding the storage of the program, the promotion, and the program guide data with a “storage unit” or a “plurality of storage units”, as recited in claims 16, 17, and 48.

Accordingly, the application shall be examined on the basis of its filling date or 01 February 2001.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the newly added claim limitations pertaining to “buffering the portion of the television . . . and recording the portion of the television program after the predetermined point from the buffer” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not

accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Response to Arguments

3. Applicant's arguments with respect to claims 1 and 35 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 6-18, 35, 36, and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al. (US Pub No. 2005/0244138 A1) in view of Zigmond et al. (US Pat No. 6,698,020).

In consideration of claim 1, Figure 10 of the O'Connor et al. reference discloses a "method for providing promotions with recorded programs". The method comprises "selecting a television program . . . to be recorded, wherein the television program is selected by a user" (Figures 11-13; Para. [0059] and [0068] – [0070]). The system subsequently, "records the selected television program. . . [and a] promotion at a predetermined point of the recording". In conjunction with performing the particular recording operation, the method involves "buffering the portion of the television program after the predetermined point in a buffer; and recording the portion of the television program after the predetermined point from the buffer" (Figures 14-16; Para. [0025], [0034], [0049] – [0053], and [0071] - [0086]). Accordingly, the reference discloses the ability for a user to simultaneously watch and record a selected television program including promotions whereupon the user may subsequently playback recorded television programs alongside with altered commercials in a time-shifted manner.

The reference, however, does not particularly disclose "selecting . . . at least one promotion . . . , wherein . . . the promotion is selected by a processor". In a related art pertaining to video distribution systems and in particular targeted promotions associated with such, the Zigmond et al. reference discloses "method" for "selecting . . . at least one promotion . . . , wherein . . . the promotion is selected by a processor" associated with the client terminal in accordance with ad selection criteria [83] (Col 6, Lines 3-12; Col 7, Lines

13-61; Col 14, Lines 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify O'Connor et al. with the teachings of Zigmond et al. for the purpose of advantageously target, deliver, and present individually targeted advertisements to viewers (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3). Taken in combination, the references provide a means such that a viewer may initially select a television program to watch/record wherein the system further selects at least one promotion to be watched/record based upon the advertising targeting criteria. Subsequently, upon the replay of the recorded television program and associated promotion, the user may potentially receive a different promotion on playback.

Claim 35 is rejected in light of the aforementioned combined teachings of O'Connor et al. and Zigmond et al.. In particular, Figure 10 illustrates a The O'Connor et al. reference illustrates a "system for providing promotions with recorded programs". The system comprises a "user input device configured to receive a user input to select a television program to be recorded" [1300] and a "processor" [1002]. The "processor" [1002] is "configured to . . . record the selected television program; record the . . . promotion at a predetermined point of the recording; buffer the portion of the television program after the predetermined point in a buffer; and record the portion of the television program after the predetermined point from the buffer" (Figures 14-16; Para. [0025], [0034], [0049] – [0053], and [0071] - [0086]). Accordingly, the reference discloses the ability for a user to simultaneously watch and record a selected television program including promotions whereupon the user may subsequently playback recorded television programs alongside with altered commercials in a time-shifted manner.

The reference, however, does not particularly teach that the processor further “selects . . . at least one promotion to be recorded”. In a related art pertaining to video distribution systems and in particular targeted promotions associated with such, the Zigmond et al. reference discloses “system” whereby “a processor [is] configured to select at least one promotion” associated with the client terminal in accordance with ad selection criteria [83] (Col 6, Lines 3-12; Col 7, Lines 13-61; Col 14, Lines 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify O’Connor et al. with the teachings of Zigmond et al. for the purpose of advantageously target, deliver, and present individually targeted advertisements to viewers (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3). Taken in combination, the references provide a means such that a viewer may initially select a television program to watch/record wherein the system further selects at least one promotion to be watched/record based upon the advertising targeting criteria. Subsequently, upon the replay of the recorded television program and associated promotion, the user may potentially receive a different promotion on playback.

Claims 2 and 36 are rejected wherein the “promotion is selected based upon the content of the program” (Zigmond et al.: Col 12, Line 60 – Col 13, Line 6).

Claim 6 is rejected wherein the method further comprises “recording both the program and the promotion on a storage unit” such as the HDD [1018] of O’Connor et al.

In consideration of claims 7, 9-11, 40, and 42-44, the Zigmond et al. reference discloses that “promotions” may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a program a promotion would be “recorded” at the “beginning of the program”, the “end of the

program”, the “beginning and the end of the program”, or “at any desired point within the program” (Zigmond et al.: Col 14, Lines 1-12; Col 16, Lines 20-43). Similarly, the playback of the aforementioned recorded media may have commercials “integrated” at different points in time.

Claims 8 and 41 are rejected wherein the O’Connor et al. reference is operable to “record a flag . . . to indicate the beginning of the program during playback” so as to locate the beginning of a particular program within the storage medium (Figures 3 and 4; Para. [0032] and [0036]).

Claims 12, 13, 16-18, 45, and 48 are rejected wherein the method further comprises “receiving the program and the promotion” and “program guide data” and subsequently “storing” them on a “storage unit” comprising a “plurality of storage units” (Zigmond et al.: Figure 5; Col 12, Line 60 – Col 13, Line 6; Col 14, Lines 1-12; Col 15, Lines 24-34).

Claims 14, 15, 46, and 47 are rejected wherein the “program, the promotion, and the program guide data are received” either via a “single broadcast channel” or via a “plurality of broadcast channels” (Zigmond et al. Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2614


SEB
November 21, 2005